

## **REMARKS**

Claims 1-5 are currently pending.

References to the paragraphs in the Office Action are referred to herein in parentheses identifying the appropriate paragraph, e.g., (para x).

Claims 1-5 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,794,210 (“Goldhaber”) (para 3).

The Office Action, dated August 12, 2004, has been carefully reviewed. Reconsideration of the grounds for the rejection is respectfully requested in view of the remarks herein.

### **Response to Office Action**

#### **A. Information Disclosure Statement:**

The Applicants note with appreciation the Examiner’s review and consideration of the references cited in the Information Disclosure Statements mailed on February 7, 2002, July 30, 2002, January 17, 2003, May 2, 2003, August 8, 2003 and March 25, 2004.

The Applicants note the Examiner has reviewed and considered the U.S. Patents cited in the Supplemental Information Disclosure Statement and Form 1449 mailed on July 30, 2002. Certain documents, however, were not considered because no dates were supplied. The Applicants transmit herewith a new Supplemental Information Disclosure Statement listing the documents not previously considered with the date the documents were retrieved from the Internet. The Applicants request the Examiner’s review and consideration of these documents.

#### **B. Rejection of claims 1-5**

The Examiner has rejected claims 1-5 under 35 U.S.C. § 103(a) as being unpatentable over Goldhaber. The Applicants respectfully traverse the Examiner’s rejection in this regard because the Examiner has failed to establish a *prima facie* case of obviousness. The MPEP states, in relevant part:

Goldhaber does not disclose the underlined claims elements as shown above for claim 1. Instead, Goldhaber discloses a method to deliver information, in the form of advertisements, to a user through mass media providers or directly from the advertisers. (Col. 11, line 59 – Col. 12, line 13.) As part of the method, a user database is created containing contact information and an user interest profile. The contact information is confidential and “[i]f an advertiser wants your name and address, he has to offer to buy it, and you have to agree to the price.” (Col. 12, lines 48-49). The interest profile includes information such as the user’s age, date of birth, gender, religion and interests. (Col. 13, lines 55-67). The user decides whether or not to disclose the user interest profile to the advertiser. (Col. 13, lines 36-37).

In contrast, claim 1 recites the limitation of “in response to a first request signal containing the non-externally identifying symbol corresponding to the end-user, transmitting the public information associated with the end-user from the hub site to a provider without permission of the end-user.” The Examiner has cited a section of Goldhaber, (Col. 15, lines 57-60) which discloses a software agent delivering the user interest profile to a server containing advertisements. The delivery of the user interest profile is not based on a request but is based on a comparison of the interest profile to the information content of the advertisements. Col. 15, lines 32-60. The Applicants respectfully submit that this delivery is not the same as responding to a request signal. Furthermore, the comparison of the interest profile with the advertisement produces a relevance index which does not contain a symbol or information identifying the user, because the user’s identity remains “anonymous” in its interest profile. Col. 15, lines 32-33; Col. 14, line 7. Unlike the above limitation of claim 1, any information provided to the server is done only with the user’s permission. (Col. 13, lines 36-37) The user decides, before any information is provided, whether or not to disclose the user interest profile to the advertiser. Id.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. MPEP § 2142.

The Applicants respectfully submit that, at a minimum, Goldhaber alone or in combination with knowledge that is well known in the art, does not disclose, teach or suggest each and every element of claims 1-5.

**1. Goldhaber does not disclose each and every element of claims 1-5**

**a. Claims 1, 2 and 5**

Claim 1 is directed to a method for storing and selectively sharing end-user information. The method is comprised of the following steps: (a) storing, in a profile database associated with the hub site, a user-record corresponding to each end-user; each user-record comprising public information that the end-user submits to the hub site and that the end-user expects will be shared with one or more of the providers without permission of the end-user, private information that the end-user submits to the hub site and that the end-user expects will not be shared with any of the providers without permission of the end-user, and a non-externally identifying symbol associated with the user-record that identifies the end-user on the network; (b) in response to a first request signal containing the non-externally identifying symbol corresponding to the end-user, transmitting the public information associated with the end-user from the hub site to a provider without permission of the end-user; and (c) in response to a second request signal containing the non-externally identifying symbol corresponding to the end-user, transmitting a permission request from the hub site to the end-user and transmitting the private information associated with the end-user from the hub site to the provider only if permission of the end-user is received in response to the permission request.

Claim 1 also requires the limitation of “in response to a second request signal containing the non-externally identifying symbol corresponding to the end-user, transmitting a permission request from the hub site to the end-user and transmitting the private information associated with the end-user from the hub site to the provider only if permission of the end-user is received in response to the permission request.” The cited section of Goldhaber describes a method presenting a user with an opportunity to view an advertisement by selecting an icon (referred to as CyberCoin). After viewing the advertisement, the user is presented with another icon, which if selected, compensates the user for disclosing its identity. The CyberCoin is a “payment or other incentive (e.g., a coupon), and encodes a network address of an information provider,” (Col. 11, lines 12-15). The Applicants submit that an icon with the network address of the information provider is not the same as a request signal containing an identifying symbol corresponding to the user.

Therefore, Goldhaber fails to disclose each and every limitation of claim 1. Likewise it fails to disclose each and every limitation of claim 5 which contains the same claim limitations as claim 1.

**b. Claim 2**

The Examiner has stated that it is well known in the art to “use authentication information for verifying legitimate service provider.” The Applicants traverse the Examiner’s statement and request evidence of the well known art as alleged by the Examiner.

**c. Claims 3 and 4**

The Examiner has failed to set forth in the Office Action how any of the features recited in dependent claims 3 and 4 are shown in the prior art. The Applicants submit that Goldhaber does not disclose, teach or suggest the claim elements of dependent claims 3 and 4.

**2. The Examiner did not show a motivation to combine**

The Examiner's arguments did not contain any statements showing that a motivation to modify or combine is found in the reference teaching of Goldhaber, the knowledge of persons of ordinary skill in the art or the nature of the problem.

Therefore, the Examiner has failed to establish a *prima facie* case of obviousness and independent claims 1 and 5 are patentable. Dependent claims 2-4 are furthermore patentable as they depend directly from patentable independent claim 1.

**CONCLUSION**

In view of the foregoing remarks, it is submitted that pending claims 1-5 are in condition for allowance. Accordingly, reconsideration and allowance of claims 1-5 are requested.

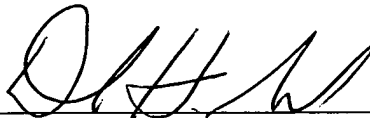
Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection presented in the Office Action mailed August 12, 2004. The Examiner is invited to contact the undersigned at 215-963-5055 to discuss any matter concerning this Application.

The Commissioner is hereby authorized by this paper to charge any fees due in connection with the filing of the response to Deposit Account No. **50-0310**.

Respectfully submitted,

Dated: 11/8/2004

By: \_\_\_\_\_



Daniel H. Golub  
Reg. No. 33,701  
Registration Number  
**MORGAN, LEWIS & BOCKIUS LLP**  
1701 Market Street  
Philadelphia, PA 19103  
Phone: (215) 963-5055  
Facsimile: (215) 963-5299



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Respectfully submitted,

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Dated: 11/8/2004

By: \_\_\_\_\_

Daniel H. Golub  
Reg. No. 33,701  
Registration Number  
**MORGAN, LEWIS & BOCKIUS LLP**  
1701 Market Street  
Philadelphia, PA 19103  
Phone: (215) 963-5055  
Facsimile: (215) 963-5299